

AMENDMENT UNDER 37 C.F.R. § 1.111 AND  
STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 10/713,197  
Attorney Docket No.: Q77283

**REMARKS**

Claims 1-11 are all the claims pending in the application. By this Amendment, Applicants cancel claim 15 without prejudice or disclaimer.

***Statement of Substance of Interview***

As an initial matter, Applicants thank the Examiner for the courtesies extended during the telephone interviews conducted on July 28, 2008 and October 20, 2008.

In the July 28<sup>th</sup> interview, Applicants' representative pointed out to the Examiner that the claims that were presented to the Examiner in the first Amendment filed in this case on April 30, 2007 did not reflect the claims as originally filed on November 17, 2003. Therefore, Applicants' representative requested the Examiner's guidance in resolving this issue. The Examiner indicated that at any time, he considers the claims of record as the claims that are filed in the latest Amendment. Therefore, in the Examiner's view, the claims that were filed in the latest Amendment on May 22, 2008 are the claims of record. If Applicants wish to conform the claims back to their originally filed form (taking into account the amendments made during prosecution), the Examiner suggested amending the currently pending claims accordingly. In accordance with the Examiner's suggestions, Applicants amend claims 6, 8, and 11 herein (in claim 6, steps f and g) so the claims reflect the originally filed claims and the amendments made during the course of prosecution.

AMENDMENT UNDER 37 C.F.R. § 1.111 AND  
STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 10/713,197  
Attorney Docket No.: Q77283

During the October 20<sup>th</sup> interview, Applicants' representative presented to the Examiner proposed amendments to the claims, a proposed statement of disavowal related to the 35 U.S.C. § 101 rejection, and briefly discussed the prior art rejection of claims 9 and 10.

Regarding the proposed amendments, the Examiner first alleged that the amendments to claims 1 and 6 included new features that were previously not presented. Applicants' representative pointed out that that claim 1 was simply amended to include the features of claim 15, and claim 6 was rewritten in independent form. Since the Examiner had indicated in the June 26, 2008 Office Action that claims 6 and 15 are allowable, it was submitted that claims 1 and 6 are in immediate condition for allowance.

Next, the 35 U.S.C. § 112 rejection and Specification objection related to claims 9 and 10 was discussed in view of the proposed amendments. The Examiner indicated that the proposed amendments are sufficient to overcome the 35 U.S.C. § 112 rejection and Specification objection.

With respect to the proposed disavowal statement in response to the 35 U.S.C. § 101 rejection, the Examiner indicated that he was not sure if such a statement could overcome the rejection. Applicants' representative encouraged the Examiner to discuss this issue with his SPE.

Finally, Applicants' representative highlighted the differences between the prior art of record and the features of claims 9 and 10. The Examiner indicated that he would take these comments into consideration and address them when they are formally filed. Accordingly, in the

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STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 10/713,197  
Attorney Docket No.: Q77283

remarks below, Applicants point out the differences between claims 9 and 10 and the prior art of record as discussed during the interview.

In view of the foregoing, Applicants respectfully submit that this Response places the application in immediate condition for allowance.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

***Allowable Subject Matter***

The Examiner has maintained that claims 6, 7, and 15 include allowable subject matter, and would be allowed if rewritten in independent form. By this Amendment, Applicants rewrite claim 6 into independent form and amend claim 1 to include the features of claim 15 as noted above. Therefore, Applicants respectfully submit that claims 1 and 6, and the dependent claims thereon, should be allowed.

Of note, in the amendment to claim 6, Applicants do not include the features of previously pending claim 14, because the Examiner had indicated in the August 13, 2007 Office Action that claim 6 would be patentable if it was rewritten to include all the features of claim 1, which at that time, did not include the features of previously pending claim 14.

***Specification Objection***

The Examiner has objected to the Specification for allegedly failing to provide proper antecedent basis for "storing the extracted edges" as set forth in claims 9 and 10. This feature has been deleted from the claims as proposed in the October 20<sup>th</sup> interview, and the Examiner

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STATEMENT OF SUBSTANCE OF INTERVIEW

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Attorney Docket No.: Q77283

agreed that based on the proposed amendment, the objection to the Specification will be overcome. Accordingly, Applicants respectfully request withdrawal of the Specification objection.

***Claim Rejections - 35 U.S.C. § 112, first paragraph***

Claims 9 and 10 rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner contends that claims 9 and 10 contain subject matter (“storing the extracted edges in a recording medium”) which is not supported by the Specification. This feature has been deleted from the claims as proposed in the October 20<sup>th</sup> interview, and the Examiner agreed that based on the proposed amendment, the 35 U.S.C. § 112, first paragraph rejection will be withdrawn. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection.

***Claim Rejections - 35 U.S.C. § 112, second paragraph***

Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. Applicants do not acquiesce to this rejection. In order to expedite prosecution, however, Applicants amend claims 9 and 10 by this Amendment. The amendments were presented to the Examiner during the October 20<sup>th</sup> interview, and the Examiner agreed that the proposed amendments overcome the 35 U.S.C. § 112, second paragraph rejection. Accordingly, Applicants respectfully submit that claims 9 and 10 comply with the requirements of 35 U.S.C. § 112.

AMENDMENT UNDER 37 C.F.R. § 1.111 AND  
STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 10/713,197  
Attorney Docket No.: Q77283

***Claim Rejections – 35 U.S.C. § 101***

Claim 11 is rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Examiner contends that the Specification does not provide “**an explicit and deliberate** (i.e., limiting) definition for ‘recording medium’ in the Specification or limiting claim language...The “**recording medium**” in claim 11 would suggest to one of ordinary skill signals or other forms of propagation and transmission media, typewritten or handwritten text on paper, or other items failing to be an appropriate manufacturer under 35 USC 101 in the **context of computer-related inventions**” (Office Action, page 4, paragraph 9).

Applicants do not acquiesce to this rejection. In order to expedite prosecution, however, Applicants submit the following statement disavowing coverage of signals and/or transmission media to overcome the § 101 rejection.

*With regard to the “recording medium” recited in the preamble of claim 11 in the present application, Applicants disavow a recording “medium” in the sense of signals transmitted via the air by means of transmitting and receiving antennae or through a vacuum. Applicants reserve the right to pursue protection of claims having a scope that includes signals that otherwise conform with 35 U.S.C. § 101. Accordingly, Applicants do not disavow coverage of signals in any related applications including any continuation applications.*

In view of the above, Applicants respectfully submit that claim 11 complies with the requirements of 35 U.S.C. § 101.

AMENDMENT UNDER 37 C.F.R. § 1.111 AND  
STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 10/713,197  
Attorney Docket No.: Q77283

***Claim Rejections – 35 U.S.C. § 103***

**Claims 1-5, 8, and 11**

Claims 1-5, 8, and 11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hannigan *et al.* (hereinafter, “Hannigan”, U.S. Patent No. 6,535,617) in view of Gu *et al.* (hereinafter, U.S. Patent No. 7,006,568).

Applicants do not acquiesce to this rejection. In order to expedite prosecution, however, Applicants amend claim 1 to include the features of allowable claim 15 as noted above. Accordingly, Applicants respectfully submit that the prior art rejection of claims 1-5, and 8 is rendered moot.

Claim 11 has been amended similar to claim 1. Therefore, claim 11 recites features similar to those discussed above with respect to claim 1. Accordingly, claim 11 is patentable for *at least* reasons similar to those given above with respect to claim 1.

**Claims 9 and 10**

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,954,549 to Kraft in view of Hannigan. For *at least* the following reasons, Applicants respectfully traverse the rejection.

For example, claim 9 relates to a method of watermarking a moving picture. The method comprises, *inter alia*, adjusting contrast of a moving image frame, extracting edges from the contrast-adjusted frame, and inserting a watermark in portions of the contrast-adjusted

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STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 10/713,197  
Attorney Docket No.: Q77283

frame from which the edges were extracted. The Examiner acknowledges that Kraft does not disclose or suggest the claimed inserting step, and relies on col. 19, lines 50-63 of Hannigan to teach the same. See Office Action, pages 8 and 9, paragraph 12. Applicants respectfully disagree.

As an initial matter, Applicants note that the cited portions of Hannigan relate to a watermark detector, i.e., Hannigan does not even remotely disclose or suggest inserting any watermark into a frame in these portions (e.g., see Hannigan: FIGS. 12 and 13, and cols. 18 and 19). Rather, in col. 10, line 61 to col. 11, line 19, where Hannigan's embedding procedure is disclosed, it is stated that the embedder combines the input image 220 and the watermark signal 226 to create the watermarked image 230. Hannigan discloses a frequency domain watermark example, in which the embedder combines the transform domain coefficients in the watermark signal to the corresponding coefficients in the input image to create a frequency domain representation of the watermarked image. Hannigan also discloses a spatial watermark example, in which the embedder combines the image samples in the watermark signal to the corresponding samples in the input image to create the watermarked image 230. *Id.* However, Hannigan is altogether silent regarding inserting the watermark signal 226 in edges of the input image 220. Therefore, claim 9 is patentable over the combined teachings of Hannigan and Kraft.

Claim 10 recites features similar to those discussed above with respect to claim 9. Therefore, claim 10 is patentable for *at least* reasons similar to those given above with respect to claim 9. Moreover, claim 10 recites "extracting edges from the current frame based on the

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STATEMENT OF SUBSTANCE OF INTERVIEW  
Application No.: 10/713,197  
Attorney Docket No.: Q77283

obtained luminance difference". Applicants respectfully submit that the prior art of record also does not disclose or suggest this feature of claim 10.

***Conclusion***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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